

Remarks

The application as submitted, the original claims and as well the amended claims make it patently clear what field of endeavor or technology the invention is associated with.

Specifically, that field is aircraft manufacture and more specifically the field of mounting ducts of varied sizes and shapes for various critical systems, for example HVAC, communication, electrical, etc., to the airframe of an aircraft. In other words, the invention is directed to mounting assemblies for mounting, i.e. installing, differently sized or shaped ducts, i.e., variable duct assemblies.

Each and every claim recites in its preamble a reference to an airframe, an airframe of an aircraft, and aircraft etc. There is no question that the preamble in the claims provides more than the setting or context in which the elements of the claim appear. The preamble sheds light on the meaning of the claims and is meaningful in defining the invention. The terms aircraft, airframe, etc., provide an additional structural limitation of the claims and as such may be relied on in order to avoid and distinguish the disclosure of the prior art. In the instant situation, the terms as noted appearing in the preamble of the claims may be deemed limitations of the claims as they give meaning to the claim and preferably define the invention. *In re Paulsen*, 30 F. 3d 1475, 31 USPQ 2d 1671, (Fed. Cir 1994).

In *Paulsen*, the term “computer” was used in the preamble of a claim to a portable computer contained within a compact “clam shell” metal case. This term was held by the court to limit the scope of the claims, which related to the mechanical elements of the case. Thus, to anticipate the claim, the prior art reference had to disclose some type of “computer”. It did and the claim was invalid as being anticipated by the prior art reference. The preamble

of the instant claims does not merely state a purpose of intended use but rather provides positive limitations of the invention claimed.

The two references relied on by the Examiner in rejecting the claims are directed to a boat rack for carrying a boat on a vehicle's roof (Dean) and to a pipe hanging system for attaching pipes by "contractors, plumbers, steam fitters, industrial electricians, and millwrights, ... in a variety of mill building constructions". (Bach – Col. 3, lines 15-17)

There is no suggestion nor would the artisan look to either of these references for help for installing pipes, tubes etc. in an aircraft where for one thing the effects of vibration, shock, surge, temperature and unwanted noise are major concern. Improperly supported pipes, tubes, etc. invite line failure and potential problems.

The references do not deal with aircraft, do not suggest that they can be applied to this field i.e. do not include this limitation and therefore are not properly applied. It is noted that the claims have been amended to recite that the flexible band is resilient and significantly stiff for supporting the ducts as recited.

The securing strap of Dean is for holding the boat against the support surface and preventing the boat from being dislodged. The band of invention is provided for "distributing a clamping load substantially across a distal surface of the duct(s).

It is still the applicants' contention that the Examiners position that the claims are unpatentable over Dean in view of Bach (35 U.S.C. 103 (a)) is not maintainable and should be withdrawn as section 103, in setting forth the test of obviousness states that " the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art and not every branch of technology". *In re Wood*, 599 F. 2d 1032, 202 USPQ 171 (C.C.P.A. 1979) Art B is analogous to Art A if a hypothetical person

seeking a solution to a problem in technology A would be likely to seek the solution by referring to information in technology B. The purpose of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problems the invention attempts to solve. *In re Clay*, 966 F. 2d 656, 23 USPQ 2d 1058 (Fed Cir. 1992).

The cited references, Dean in particular, are directed to technology that is so far removed from the field to which the instant invention pertains that it is from a nonanalogous art and cannot properly be considered in determining obviousness under 35 U.S.C. 103. The combination of Dean and Bach is improper and the rejection therefore should be withdrawn.

In view of the above, claims 1-9 and 23-35 should be allowable and notification to this effect is respectfully requested.

Respectfully submitted,
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